REMARKS

Amendments to the Claims

Currently, claims 1, 3, and 5-13 are pending. Applicants have amended claims 1 and 8 to fix a typographical error. Specifically, in claim 1, line 4, Applicants have inserted an "and" between "carboxylic acid amides" and "carboxylic acid esters" to obviate the "possible confusion" that is referred to by the Examiner on page 2 of the Office Action. Claim 8 has been similarly amended to insert "and" between "sulfonic acid ester" and "carboxylic acid esters". Applicants submit that no new matter has been added as a result of this amendment.

Rejection of Claims 1, 3, and 5-13 Under 35 U.S.C. §103(a)

The Office Action continues to reject claims 1, 3, and 5-13 under 35 U.S.C. §103(a), as being obvious over the combined teachings of Mawatori et al. (U.S. Patent 5,614,568) and Hozumi et al. (U.S. Patent 5,374,600). Applicants respectfully traverse the rejection.

First, as discussed in the *Manuel of Patent Examining Procedure* ("*MPEP*") Section 2141.01(a), in order for an Examiner to rely on a reference as a basis for a rejection, the reference must either be in the "field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Applicants submit that Hozumi et al. simply does not fall within the same technical field as the presently claimed invention and is not reasonably pertinent to the particular problem to which the inventors were concerned and thus is not appropriate prior art for reliance upon by the Examiner. Specifically, Hozumi et al. relate to a technical field targeting an agent for use in a special substance, namely in a swelling absorbent for oil. This absorbent absorbs oil discarded or leaked from plants or the like in order to reduce marine pollution (See, column 1 lines 25-33). This technical field is **far** from the technical field of the present invention which relates to a pesticidal resin that

can be used in electric equipment, transport equipment, etc. Furthermore, the advantages and objects of Hozumi et al., namely, releasing insecticidal compositions, are intended to be produced and achieved in **sea water,** which is far from the advantages and objects of the currently claimed pesticidal resin. In view of this, Applicants respectfully request that the Examiner provide specific and clear reasons why Hozumni et al. should be deemed to be analogous prior art.

Second, Applicants submit that there is no teaching, suggestion or motivation, either implicitly or explicitly, for the Examiner to combine Hozumi et al. and Mawatori et al. Specifically, the inventions taught in each of these two patents are completely different from each other with respect to the conditions under which each of these inventions is used, their functions and their advantages. Therefore, the functions and advantages pointed out by the Examiner simply do not provide any motivation to combine Hozumi et al. and Mawatori et al. Specifically, the resin disclosed in Mawatori et al. is intended to be used in the electrical and electronics fields, office automation field, household appliance field, automobile field, sanitary product field and the field of products intended for daily use. In all of these fields, the resin is in contact with air. In contrast, as mentioned previously herein, the oil-absorbent agent disclosed in Hozumi et al. is used in sea water. It is apparent therefore, that the oil-absorbent agent and resin of Hozumi et al. and Mawatori et al. are exposed to completely different environments. Exposure to different environments necessitates that the resin of Mawatori et al. have its chemical components released by "diffusion in to the atmosphere". In contrast, the oil-absorbent agent of Hozumi et al. has its chemical components released by "dissolving in sea water." These mechanisms of release are completely different from each other in operation and in the rate of progress. Therefore, although Hozumi et al. recognize the advantages of compositions that permit the controlled release of pesticides as pointed out by the Examiner, these advantages are only realized when the oil-absorbent agent is used in sea water. Thereupon, the functions and advantages of the oil-absorbent agent disclosed in Hozumi et al. are completely different from the functions and advantages of the resin disclosed in Mawatori et al. Thereupon, the Examiner's assumption that the

advantages and functions of both patents are the same is erroneous. In addition, if the oil-absorbent agent (namely, an agent that does not contain any fibrous inorganic filler) of Hozumi et al. provides the advantage and function to permit controlled release of pesticides, inherently, this suggests that a given advantage can be provided even without the use of fibrous inorganic filler (see, component (D) of claims 1 and 8). Therefore, the teaching of Hozumi et al. is opposite to the currently claimed invention which necessitates that the resin contain a fibrous inorganic filler (see component (D) in claims 1 and 8). Thereupon, for the reasons discussed herein, the combination of Hozumi et al. with Mawatori et al. is improper.

Third, polyamides, which are not "special" resins but instead are "commodity" resins that are applicable in various fields, simply do not contribute to any motivation to combine Hozumi et al. with Mawatori et al. Specifically, polyamides are used in a wide number of applications including not only electric equipment, automobile and sanitary products, but also in products intended for daily use, various industrial products and even spacesuits. Therefore, the fact that polyamides are commonly used in both Hozumi et al. and Mawatori et al. simply does not contribute to any motivation to combine Hozumi et al. with Mawatori et al.

Fourth, assuming *arguendo* that Hozumi et al. disclose that the pesticides are able to be included equally as antimicrobials and insecticides, this teaching only provides an example of an "under water dissolving chemical agent." That is, the chemical components disclosed in Hozumi et al. are taught for use in sea water and no portion of this patent discloses or suggests that the oil-absorbent agent can be used in the air. It is apparent that the Examiner does not take into account the condition under which the oil-absorbent agent and resin disclosed in the cited patents are used and the advantages and functions to be produced under the conditions that these respective products are used. Thereupon, it is apparent that the Examiner's rejection is not based on a correct understanding of the invention described in each of the patents as a whole. Instead, the Examiner seems to be picking and choosing portions of each patent in an arbitrary

manner. Therefore, for the reasons discussed herein, there is nothing in either of these two patents that contributes to a motivation for their combination.

Fifth, it is to be noted that perlite is not cited as an example of fibrous substance in Hozumi et al. Therefore, the Examiner's understanding on this point is simply erroneous. Specifically, Hozumi et al. describe that "the swellable oil-absorbent agent may be used as combined with such known oil absorbents or fillers as rice hull, straw, pulpy cotton, porous lime, porous silica, porous perlite, and polypropylene fiber", and the "porous perlite" is exemplified as a substance that absorbs oil. The perlite mentioned by the Examiner is an inorganic and granular substance, **it is not a fibrous substance**. Thereupon, the perlite referred to by the Examiner does not relate to the fibrous substance disclosed in Mawatori et al. or component (D) as recited in claims 1 and 8 of the present invention, and therefore simply does not contribute to a motivation to combine Hozumi et al. with Mawatori et al. Therefore, it is apparent based on the reasons described herein that Examiner has an erroneous understanding of the references and that there is simply no motivation to combine Hozumi et al. with Mawatori et al.

According to the recent decision *In re Leonard R. Kahn*, 441 F.3d 977 (Fed. Cir. 2006), in order to establish a *prima facie* case of obviousness based on combination of elements disclosed in the prior art requires that the Board (or, in this case, the Examiner), to explain the reasons "one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. *Id.* at 986. The Federal Circuit also stated that "[W]hen the Board does not explain the motivation, the suggestion or teaching that would have led the skilled artisan at the time to the claimed combination as a whole, we infer that the Board used hindsight analysis to conclude that the invention was obvious". *Id.* at 986. Applicants submit that in the instant case, in order to conclude that the claimed invention is obvious based on the combination of Hozumi et al. and Mawatori et al., which are different from each other in their respective technical fields, the Examiner must explain the motivation, suggestion or teaching that would have led one skilled in the art to combine the teachings of Hozumi et

al. with Mawatori et al. For the reasons discussed previously herein, there is absolutely no motivation, suggestion or teaching in Hozumi et al. or Mawatori et al. that would have lead one skilled in the art to combine these references. Therefore, the Examiner's rejection is improper and should be withdrawn.

In addition to the above reasons, the claimed subject matter is patentable as the claimed resin exhibits unexpected functions and advantages that would not be expected by one skilled in the art based on the teachings of Hozumi et al. or Mawatori et al. It is apparent that the Examiner does not correctly understand these secondary considerations or neglects them in their entirety.

Specifically, the claimed resin composition comprises the (B) component such as sulfone amides and the (D) component the fibrous "inorganic filler", as well as the (C) component as a chemical agent having a pesticidal property, so that it is possible to keep the (C) component in the resin for a prolonged period of time and allow the same to be gradually released from the resin. Thereupon, the claimed resin exhibits the significant advantage that the pesticidal activity can be exhibited for a prolonged period of time.

In contrast, Mawatori et al. do not disclose or suggest the (C) component and the (B) component as currently recited in claims 1 and 8. Mawatori et al. do disclose the (D) component, namely, the at least one fibrous inorganic filler. Because Mawatori et al. teach a resin that has a very different composition than the claimed resin, Applicants believe that it is unlikely that the resin taught by Mawatori et al. would exhibit the same advantages and functions as the currently claimed resin.

In comparison, Hozumi et al. is completely silent on the use of the fibrous "inorganic" filler as recited in the (D) component of the presently claimed invention. From this, it is apparent that Hozumi et al. neither discloses, suggests or teaches any advantages produced by the use of the (D) component. Furthermore, any advantages to the oil-absorbent agent disclosed in Hozumi et al. are produced in water and not in the

air. In contrast, the pesticidal resin composition of the present invention comprises four components, namely, the (A) component, the (B) component, the (C) component and the (D) component. The combination of these components, (A)-(D), produces a number of advantages, none of which is disclosed or suggested in either Hozumi et al. or Mawatori et al. These advantages are that the claimed resin can be used in electric equipment, transport equipment, etc. and that the claimed resin achieves sustained release to the air. What's more, the claimed resin achieves an improved sustained release in to the air. This advantage is fully supported in the examples of the description of this application.

Although the Examiner points out that Hozumi et al. produces an effect similar to that of the present invention, Applicants believe that it is unlikely that Hozumi et al. who exhibit the same effect when the (D) component has been added, since Hozumi et al. discloses an oil-absorbent agent that does not contain any fibrous inorganic filler as the (D) component. Specifically, Hozumi et al. is silent on how long the effect can last when the (D) component has been added. In this respect, the Examiner has misconstrued the teachings of the Hozumi et al. and Mawatori et al. references, and misinterpreted or neglected the significant advantages provided by the claimed pesticidal resin. Under these circumstances, the Examiner is requested to fully review the evidence of unexpected results which are contained in the examples of the present application, correctly interpret the significant advantages provided by the claimed pesticidal resin of the present present invention and appropriately examine the present application.

CONCLUSION

Applicants respectfully submit that the claims comply with the requirements of 35 U.S.C. Section 103. Accordingly, a Notice of Allowance is believed in order and is respectfully requested.

Should the Examiner have any questions concerning the above, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below. If the Examiner notes any matters which the Examiner believes may be expedited by a telephone interview, the Examiner is requested to contact the undersigned.

Respectfully submitted,

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